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In re Application of
Korman et al.
Application No. 09/644,668
Filed: August 24, 2000
Attorney Docket No. 04280/100M321-US1

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: **DECISION GRANTING REQUEST**
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This decision is in response to applicants' submission of a paper titled 'REQUEST FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)' timely filed¹ on February 28, 2005 requesting that the Office adjust the PTA at the time of the mailing of the notice of allowance from an adjustment of six (6) days to an adjustment of six hundred and thirteen (613) days.

Applicants' PTA is **GRANTED to the extent herein indicated**. The Office will adjust the PAIR calculation to reflect this decision. The correct determination at the time of the mailing of the notice of allowance is 259 days. As for the three year determination, the request will be **HELD IN ABEYANCE** until the issue date is determined.

Applicants argue that the actual amount of PTA is six hundred and three days. Applicants assert that the Office should be entitled to a period of "at least 613 days for failing to issue the application within three years of the filing date under 37 CFR 1.702(b)". Applicants assert that the period of adjustment runs from August 25, 2003 until the date of patent issuance. Applicants further assert that because the four hundred and nineteen days of PTA will overlap with the amount of PTA earned for the three year provision, the actual amount of Office delay will be equivalent to the amount of delay for failing to issue the application within three years of the filing date. Applicants also contest two of the periods of reductions for applicants failures to engage in reasonable efforts to conclude prosecution of the application. Applicants do not contest the forty-day reduction under 37 CFR 1.704(b) for the submission of a reply on January 5, 2004.² However, applicants do contest the two hundred and ninety-five day reduction under 37 CFR 1.704(b) and the seventy-eight (78) day reduction under 37 CFR 1.704(c)(8).

Applicants arguments are persuasive to the extent herein indicated.

The instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual

¹Issue fee paid on March 3, 2005.

²The Office action was mailed on August 26, 2003 and applicant had until November 26, 2003 to reply without violating 37 CFR 1.704(b). The reduction was for the period beginning on November 27, 2003 and ending on January 5, 2004, a forty-day delay.

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date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentee may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

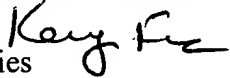
As for the two periods of reduction for applicants failure to engage in reasonable efforts to conclude processing and examination of the application, applicants are correct that such reductions are in error. The Office erred in assessing a two hundred and ninety-five day delay for failing to reply to the notice of missing parts within three months of the mail date of the notice. The record reflect that the notice was mailed on October 16, 2000 and was responded to in full on May 18, 2001, one hundred and twenty-two (122) days beyond the three month time period. In addition, the Office erred in assessing a seventy-eight (78) day delay against applicant for the submission of a supplemental response on March 23, 2004 because the record reflects that the supplemental paper (amendment) provides support for applicants assertion that the supplemental amendment was expressly requested by the examiner. Accordingly, the Office finds that applicants engaged in delays of one hundred and sixty two days ($122 + 40 = 162$). Accordingly, at the time of the mailing of the notice of allowance the proper amount of PTA is two hundred and fifty-nine day ($419 - 162 = 259$).

After the mailing of this decision, this application will be forwarded to the Office of patent publications for a prompt issuance of the patent. The Office apologizes for any delays in this decision and notes that any delays in issuing the application within four months of the payment of the issue fee and all other requirements being satisfied will be added to the determination that is mailed with the issue notification letter.

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The Office has assessed the \$200.00 application fee. No additional fees are required of applicants.

Any questions related to this decision should be directed to Kery Fries at 571-272-7757.


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